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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SHRESTHA, BLENDRA K				
ART UNIT		PAPER NUMBER		
3691				
NOTIFICATION DATE		DELIVERY MODE		
02/22/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/816,120

Applicant(s)

GAUBATZ ET AL.

Examiner

BIJENDRA K. SHRESTHA

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 21-30 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 21-30 and 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Non-Final Office action is in response to the response filed on February 12, 2010. Claims 1-10, 21-30 and 44-49 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/2010 has been entered.

Double Patenting

The applicant is requested to submit terminal disclaimer against Application # 10/594,993 in order to overcome obviousness-type double-patenting rejection. The applicant has provided in the Request for Continued Examiner that the terminal disclaimer has been filed but no such document is present in the response filed.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20, 21-30, 44-46 and 48-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a system yet the body of the claim fails to recite any structural components that would constitute a system. The body of the claim recites modules (unit) for identification, determination, division, calculation, comparison, correction which is related to software. Software per se is non statutory subject matter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-30, 44-46 and 48-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification do not describe identifying unit, determining unit (first, second, third, and fourth), dividing unit, calculating unit, comparing unit, modifying unit, adjustment unit. Appropriate correction is required.

Examiner reviewed the applicant cited portion page 3, lines 19-20; page 4, lines 17-19 and page 5, lines 10-12 of the specification in the response filed. The cited

portion provides steps of "identifying...; determining.....;dividing ...; and comparing...." as recited in claim 1. The "processing block" depicted in Fig. 1 represents processing steps of "acquire, determine, calculate, fix, and adjust".

Examiner interprets identifying, determining, dividing, calculating, comparing, modifying and adjustment is performed by software for the prosecution of this application.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-30, 44-46 and 48-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 21 and 44 recite in the preamble "a system having at least one hardware processor...." the body of the claim does not contain any limitations indicating the structure of the system. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant's claimed limitations consist of "an identifying unit, a determining unit, a dividing unit, a calculating unit, a comparing unit". The specification did not describe these units except steps of identifying, determining, dividing, calculating and comparing without specifying whether these steps are performed by a software or hardware. Appropriate correction is required.

Examiner reviewed the applicant cited portion page 3, lines 19-20; page 4, lines 17-19 and page 5, lines 10-12 of the specification in the response filed. The cited portion provides steps of "identifying...; determining.....; dividing ...; and comparing...." which is performed by the processor as recited in claim 1. The "processing block" depicted in Fig. 1 represents processing steps of "acquire, determine, calculate, fix, and adjust".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 , 21-30 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg, U.S. Patent No. 6,456,979 (reference A in attached PTO-892) in view of Moller et al. (BMJ, June 1995) (reference U in attached PTO-892) further in view of Silver, U.S. Patent No. 6,269,339 (reference B in attached PTO-892).

6. As per claim 1 and 21, Flagg teaches a method of characterizing relative risks associated with a plurality of financial products_performed on a computer having a hardware processor, comprising the steps of:

a) identifying one or more risk classes associated with the plurality of financial products by using an input device of the computer (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class)).

Flagg does not teach b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates by said step of determining by an average rate to determine a relative risk ratio for each of the risk classes and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying to determine a dependence between the at least two different risk classes; and comparing the relative risk ratios and the correlated risk ratios by the processor to characterize the relative risks associated with the plurality of products.

Moller et al. teach b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step of determining by an average rate (Moller et al., Table, Expected, Relative Risk, paragraph 3; where expected occurrence and relative risk ratio of cancer in Denmark for period 1977-89 is shown) and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying (see Table, page 1 and 2, column Observed No; where correlation between number of observed number of different types of cancer to data of 7046 people with primary diagnosis of Parkinson's disease in Denmark, 1977-89); and comparing the relative risk ratios and the correlated risk ratios (Moller et al, Table, Relative Risk, page 1-2; where Table illustrate comparison of "Observed Number" of specific cancer to 7046 people with Parkinson's disease in column 2 to "Relative Risk with 95% confidence interval" in column 4).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step of determining by an average rate and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying; and comparing the relative risk ratios and the correlated risk ratios of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

Flagg does not teach comparing the relative risk ratios by the processor with empirical data to generate comparative risk data to characterize the relative risks associated with the plurality of products; correcting the relative risk ratios in a case the comparative risk data is out of a defined range comparing with the empirical data; and storing the corrected risk ratios to a storage unit of the computer.

Silver teaches comparing the relative risk ratios by the processor with empirical data to generate comparative risk data to characterize the relative risks associated with the plurality of products; correcting the relative risk ratios in a case the comparative risk data is out of a defined range comparing with the empirical data; and storing the corrected risk ratios to a storage unit of the computer (Silver, Fig. 11, column 1, lines 17-22; column 7, lines 59-67; where current relative risk is compared with preferred level of risk in wellness plan and continuously improved the user relative risk level).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include comparing the relative risk ratios by the processor with empirical data *to generate comparative risk data to characterize the relative risks associated with the plurality of products*; correcting the relative risk ratios in a case the comparative risk data is out of a defined range comparing with the empirical data; and storing the corrected risk ratios to a storage unit of the computer of Flagg because Silver teaches including above feature would provide user with the means of measuring and enhancing his or progress toward improved wellness (Silver, column 1, lines 20-22)..

The claim language "*to determine a relative risk ratio for each of the risk classes, to determine a dependence between the at least two different risk classes, to characterize the relative risks associated with the plurality of products and to generate comparative risk data to characterize the relative risks associated with the plurality of products*" represent intended use language and therefore do not carry any patentable weight (see MPEP form paragraph 7-37-09).

7. As per claim 2 and 22, Flagg in view of Moller et al. further in view of Silver teach claim 1 as described above. Flagg further teach the system and method, wherein said one or more risk classes are associated with one or more criteria, and further comprising

the steps of modifying one or more of said criteria and repeating said steps of determining, dividing, calculating and comparing (see Fig. 2; where risk classes are based on gender and lifestyle/health profiles).

The claim language *"to determine an impact of said modification on the relative risks associated with the products"* pertains to intended use language that do not carry any patentable weight (see MPEP form paragraph 7-37-09).

8. As per claim 3-5 and 23-25, Flagg in view of Moller et al. further in view of Silver teach claim 1 as described above. Flagg further teach the system and method, wherein one or more of said risk classes are associated with different criteria (see Fig. 2; where risk classes are based on gender and lifestyle/health criteria)

Flagg does not teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks.

Moller et al. teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include relative risk ratios are used to compare said risk classes of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

9. As per claim 6 and 26, Flagg in view of Moller et al. further in view of Silver teach claim 1 as described above. Flagg further teach the system and method comprising

the step of storing data in data storage of said computer relating to prevalence of criteria associated with said risk classes (see Fig. 1; column 23, lines 23-29; where server stores insurance prevalence criteria as shown in Fig.2).

The claim language "*for use in determining the relative risk ratios*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

10. As per claim 7 and 27, Flagg in view of Moller et al. further in view of Silver teach claim 6 as described above. Flagg further teach the system and method comprising

the steps of comparing the prevalence data to industry empirical data for particular combinations of criteria and, if necessary, adjusting the stored data to agree with the empirical data (see Fig. 2, steps 70 and 90).

11. As per claim 8 and 28, Flagg in view of Moller et al. further in view of Silver teach claim 1 as described above. Flagg further teach the system and method, comprising

the step of storing data relating to the expected occurrence rates (see Fig. 1, client data server; where server can store any data)

The claim language "*for use in determining the relative risk ratios*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

12. As per claim 9 and 29, Flagg in view of Moller et al. further in view of Silver teach claim 8 as described above.

Flagg does not teach the steps of adjusting the corrected risk ratios stored data to agree with the empirical data.

Silver teaches the steps of adjusting the corrected risk ratios stored data to agree with the empirical data (Silver, Fig. 11, column 1, lines 17-22; where current relative risk is compared with preferred level of risk in wellness plan and continuously improved the user relative risk level).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include the steps of adjusting the corrected risk ratios stored data to agree with the empirical data of Flagg because Silver teaches including above feature would provide user with the means of measuring and enhancing his or progress toward improved wellness (Silver, column 1, lines 20-22)..

13. As per claim 10 and 30, Flagg in view of Moller et al. further in view of Silver teach claim 2 as described above. Flagg further teach the system and method,

Flagg does not the step of using the relative risk ratio.

Moller et al. teach the step of using the relative risk ratio (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer are compared).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the step of using the relative risk ratio of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

The claim language *"to determine an impact on a risk class of including in that class one or more risks that do not meet one or more of the criteria associated with that class"* pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

14. As per claim 44, Flagg in view of Moller et al. further in view of Silver teach claim 1 and 21 as described above.

Flagg further teaches means for comparing the risk and excluding the individual risk from the risk class, in a case where the comparing unit has determined that the class ratio is out of a defined range in comparison with pre-stored empirical data (see Fig. 2; where risk compared include gender and lifestyle/health based)

Flagg does not teach comparing relative risk ratio of the individual to the relative risk ratio of the risk class

Moller et al. teach means for comparing relative risk ratio of the individual to the relative risk ratio of the risk class (Moller et al., Page 1-2, Table)

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include comparing relative risk ratio of the individual to the relative risk ratio of the risk class of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

The claim language "*to determine a class ratio*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

15. As per claim 45-46, Flagg in view of Moller et al. further in view of Silver teach claim 44 as described above. Flagg further teach the system, wherein

one or more of said risk classes are associated with a plurality of criteria (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class);

Flagg does not teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria.

Moller et al. teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared including subgroups other skin cancer, all other specified cancer and cancer associated with tobacco smoking).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include determining relative risk ratios for subgroups of

criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

16. As per claims 47, 48 and 49, Flagg in view of Moller et al. further in view of Silver teach claim 3, 23 and 45 respectively as described above.

Flagg does not teach further teach the method of characterizing relative risks, wherein the different criteria used for the risk classes are diastolic blood pressure and systolic blood pressure.

The Examiner notes, data identifying the specific type of risk classes is not functionally related to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *Cf. In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401 , 404 (Fed. Cir. 1983)., *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

However, Otvos (U.S. Patent No. 6,576,471(reference C in attached PTO-892)) provide risk classes based on Blood Pressure (Systolic/Diastolic) (Otvos, Fig. 2, Risk Factor Chart (71), Relative Risk is moderate blood pressure of 132/86).

Remarks

17. Examiner would like to direct applicant attention to **intended use language** in claims 1-4, 6, 8, 10, 21-22, 24-30 and 44-46 of the instant application as described above. These limitations are not positively claimed, and therefore, are not given any patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim (see MPEP form paragraph 7-37-09).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon;

Abrahams et al. (U.S. Pub No. 2008/0091490) teach system for managing risk.

Buckner et al. (U.S. Pub No. 2003/0236685) teach preferred life mortality systems and methods.

DeTore et al. (U.S. Patent No. 4,975,840) teach method and apparatus for evaluating a potentially insurable risk.

Gaubatz et al. (U.S. Pub No. 2003/0101132) teach system and method for developing loss assumptions.

Gunewardena et al. (U.S. Pub No. 2003/0023543) teach method, software program, and system for ranking relative risk of plurality of transactions.

Fickes (U.S. Pub No. 2005/0262014) teaches relative valuation systems.

Messmer et al. (U.S. Pub No. 2004/0225587) teach risk categorization in underwriting a financial risk instrument application.

Otvos (U.S. Patent no. 6,576,471) teaches analyzing risk assessment result.

Robertson et al. (U.S. Pub No. 2004/0024620) teach risk classification methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 8:00 AM-4:30 PM (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bijendra K. Shrestha/
Examiner, Art Unit 3691
02/14/2010